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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/075,666	05/11/1998	TETSUJIRO KONDO	450100-2780.	3934

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EXAMINER

CHANG, JON CARLTON

ART UNIT PAPER NUMBER

2623

DATE MAILED: 12/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/075,666

Applicant(s)

KONDO, TETSUJIRO

Examiner

Jon Chang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/061730.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2003 has been entered.

Response to Applicant's Amendment and Arguments

2. The amendment filed July 17, 2003, has been entered and made of record.

Applicant has amended the claims to include the recitation, "said second digital image signal being independent from said first digital image signal and being generated other than by interpolation thereof." Applicant alleges that this does not constitute new matter, and is supported at column 6, lines 1-7 (page 8 of the response). The Examiner disagrees. Column 6, lines 1-7, read, "...In FIG.7, a digital HD video signal is supplied to an input terminal indicated at 51. It is desirable that the HD video is a standard-like signal taking into account the generation of the mapping tables. Actually, by taking a standard picture with a HD video camera or by recording a taken picture signal onto HDVTR, a HD video signal can be provided." This does not appear to have any explicit or implicit support for "the second digital image signal being independent from the first digital image signal, and being generated other than by interpolation thereof." Nothing in the text seems to indicate that the second digital image signal is independent from

the first digital image signal. Nothing in the text mentions how the second digital image signal is generated (i.e., by interpolation or not by interpolation). The Examiner cannot find any support in the original disclosure for the newly claimed language.

Not only does the original disclosure not support the newly claimed recitation, the original disclosure actually teaches away from the recitation. For example, regarding the embodiment corresponding to the description given at column 6, lines 1-7 (mentioned by Applicant), the patent states at column 5, lines 43-48, "...In FIG. 6, picture element data **interpolated** by circles O belongs to the SD picture, while picture element data indicated by crosses X belongs to the HD picture. For example, four picture element data y1 to y4 of the HD picture is **generated from** twelve picture elements data of the SD picture. "(emphasis added). First, this shows that the interpolation is occurring. Second, the HD picture (i.e., the second digital image signal) is dependent on the SD picture (i.e., the first digital image signal) since the HD picture is generated from the SD picture.

Furthermore, the invention as a whole is concerned with interpolation of a low resolution image signal to obtain a higher resolution image signal. Note: 1) abstract, last sentence; 2) column 6, lines 42-46.

Additionally, comments made by Applicant during the prosecution of the current application opposes this new language. Applicant actually states, explicitly, that interpolation is being performed. Note for example, in the amendment submitted March 27, 2001, on page 10, in the full paragraph on the page, the Applicant states, "However, in the claimed invention, this is not the case. Rather, all of the data of the second digital

image area **interpolated...**" (emphasis added). There are instances of Applicant stating that the invention performs interpolation.

Based on the above, the Examiner considers the language added to claims 15, 19, 23, 27, 30, 33 and 36, to be new matter.

With regard to the Kanno patent, the Examiner agrees that Kanno does not teach the invention as claimed (specifically, Kanno does not teach the newly added feature of, "said second digital image signal being independent from said first digital image signal and being generated other than by interpolation thereof."). Therefore, the rejections relying on Kanno are withdrawn.

Claim Rejections - 35 USC § 112

3. Claims 15-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language, " said second digital image signal being independent from said first digital image signal and being generated other than by interpolation thereof" and similar language, in claims 15, 19, 23, 27, 30, 33 and 36 is not supported by the original disclosure.

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4. Claims 15-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not explain how the second digital image signal is generated other than by interpolation of the first digital image signal, and further how the second digital image signal is independent from the first digital image signal.

Allowable Subject Matter

5. Claims 1-14 are allowed.


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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.


Jon Chang
Primary Examiner
Art Unit 2623

Jon Chang
December 3, 2003